

REMARKS

Claims 1-43 were examined. Claims 1, 3-5, 16, 26-28 and 37 are amended. Claims 25 is canceled. Claims 1-43 remain in the Application.

The Patent Office rejects claims 1-43 under the judicially created doctrine of obviousness-type double patenting. The Patent Office rejects claims 1-3, 7, 10, 14-16, 19-22, 25, 28 and 42-43 under 35 U.S.C. §102(b). The Patent Office rejects claims 17 under 35 U.S.C. §103(a). Reconsideration of the pending claims is respectfully requested in view of the above amendments and the following remarks.

A. Obviousness-Type Double Patenting: Rejection of Claims 1-12, 14-35 & 37-41

The Patent Office rejects claims 1-12, 14-35 and 37-41 under the judicially created doctrine of obviousness-type double patenting as obvious over claims 1, 3-4 and 6-27 of U.S. Patent No. 6,428,539. Applicants include herewith a terminal disclaimer disclaiming the terminal part of any patent granted to claims 1-12, 14-35 and 37-41 to the term of U.S. Patent No. 6,428,539. Applicants respectfully request that the Patent Office withdraw the rejection to claims 1-12, 14-35 and 37-41 under the judicially created doctrine of obviousness-type double patenting.

B. Obviousness-Type Double Patenting: Rejection of Claims 1-8, 10-17, 19, 22, 25, 28-29 & 36-43

The Patent Office rejects claims 1-8, 10-17, 19, 22, 25, 28-29 and 36-43 under the judicially created doctrine of obviousness-type double patenting as obvious over claims 1-6 and 8-18 of U.S. Patent No. 6,702,813. Applicants include herewith a terminal disclaimer disclaiming the terminal part of any patent granted to claims 1-8, 10-17, 19, 22, 25, 28-29 and 36-43 to the term of U.S. Patent No. 6,702,813. Applicants respectfully request that the Patent Office withdraw the rejection to claims 1-8, 10-17, 19, 22, 25, 28-29 and 36-43 under the judicially created doctrine of obviousness-type double patenting.

C. 35 U.S.C. §102(b): Rejection of Claims 1-3, 7, 10, 14-15, 28 & 42-43

The Patent Office rejects claims 1-3, 7, 10, 14-15, 28 and 42-43 under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 5,810,809 of Rydell (Rydell).

Independent claim 1 is not anticipated by Rydell, because Rydell does not describe a surgical instrument comprising a tube having a distal end and a proximal end and defining a lumen therethrough, and the distal end including a cutting edge, and a shaft within the lumen of the tube and having a distal end including a blade, wherein the lumen of the tube has a dimension suitable to accommodate an auxiliary instrument in addition to the shaft. With respect to the lumen having a dimension suitable to accommodate an auxiliary instrument in addition to the shaft, this is described in the Application at, for example, page 13, lines 5-12.

Rydell describes an arthroscopy instrument for debriding tissue including inner tubular cutter member 24 including opening 23 and outer tubular member 20 including opening 22. In use, tissue is effectively macerated and sucked back through lumen 54 in the handle back to collection jaw 28, via tubing 30. See col. 5, lines 5-54. No lumen for an auxiliary instrument is described.

Claims 2-3, 7, 10, and 14-15 depends from claim 1 and therefore contain all the limitations of that claim. For at least the reasons stated with respect to claim 1, claims 2-3, 7, 10 and 14-15 are not anticipated by Rydell.

Independent claim 28 is not anticipated by Rydell, because Rydell does not describe a surgical instrument comprising a handle comprising a longitudinal dimension; a tube extending from the handle and having a distal end and a cutting edge, the tubular shaft defining a lumen coaxial with the tube and having a cutting edge at its distal end, wherein the lumen of the handle is aligned with the lumen of the tubular shaft. Support for this alignment may be found in the Application, for example, with respect to Figure 2B and the accompanying text. Rydell describes a lumen through handle 14, but it does not describe the lumen as aligned with, for example, inner cutter member 24 such that an auxiliary instrument may be inserted at a proximal end of said handle and through the lumen of the handle and the lumen of the tubular shaft.

Independent claim 42 is not anticipated by Rydell because Rydell does not describe a method for cutting body tissue including inserting a surgical instrument; inserting an auxiliary instrument through the surgical instrument, aligning body tissue to be cut between a cutting edge and blade of the surgical instrument; and rotating the surgical instrument to cut the body tissue. As noted above, Rydell does not provide a device to accommodate inserting an auxiliary instrument therethrough.

Claim 43 depends from claim 42 and therefore contain all the limitations of that claim. For at least the reasons stated with respect to claim 42, claim 43 is not anticipated by Rydell.

Applicants respectfully request that the Patent Office withdraw the rejection to claims 1-3, 7, 10, 14-15, 28 and 42-43 under 35 U.S.C. §102(b).

D. 35 U.S.C. §102(b): Rejection of Claims 16, 19-22 & 25

The Patent Office rejects claims 16, 19-22 and 25 under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 5,112,299 of Pascaloff (Pascaloff).

Claim 16 is not anticipated by Pascaloff because Pascaloff does not describe a surgical instrument including a tube having a distal end including an outer cutting edge extending longitudinally therefrom. Pascaloff describes sheath member 20 including a pair of longitudinally extending, diametrically opposed tabs 44 and 46 and cutting blade member 18 having serrated edges 70, 72, 74 and 76 on distal tabs 52 and 54. When cutting member 18 rotates within sheath member 20, the serrated edges of tabs 52 and 54 affect a cutting action in cooperation with the straight cutting edges on tabs 44 and 46 of sheath member 20 to sever tissue. Thus, Pascaloff does not disclose an outer cutting edge extending longitudinally from the tube and a blade extending longitudinally from the tubular shaft.

Claims 19-22 depend from claim 16 and therefore contain all the limitations of that claim. For at least the reasons stated with respect to claim 16, claims 19-22 are not anticipated by Pascaloff.

Applicants respectfully request that the Patent Office withdraw the rejection to claims 16 and 19-22 under 35 U.S.C. §102(b).

E. 35 U.S.C. §103(a): Rejection of Claim 17

The Patent Office rejects claim 17 under 35 U.S.C. §103(a) as obvious over Pascaloff and Rydell. Rydell is cited for the teaching of electrically energizing either the blade or the outer cutting edge of the surgical instrument of Pascaloff. Claim 17 depends from claim 16 and therefore contains all the limitations of that claim. Claim 17 is not obvious over the cited references, because the references fail to disclose provide any motivation for a surgical instrument including a tube having an outer cutting edge extending longitudinally therefrom, the tubular shaft including a blade extending longitudinally from a distal end and a lumen of a

tubular shaft having a dimension suitable to accommodate an auxiliary instrument. In this regard, the discussion of each of Pascaloff and Rydell with respect to previously discussed claim is relevant here as is the discussion of Rydell with respect to claim 1. Applicants respectfully request the Patent Office withdraw the rejection to claim 17 under 35 U.S.C. §103(a).

F. Information Disclosure Statement

Applicants submit herewith Form PTO/SB/08 that Applicants believe complies with 37 CFR §1.98(a)(1). Applicants respectfully request that the references listed on the enclosed Form PTO/SB/08 be considered.

CONCLUSION

In view of the foregoing, it is believed that all claims now pending patentably define the subject invention over the prior art of record and are in condition for allowance and such action is earnestly solicited at the earliest possible date.

Respectfully submitted,

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Date: _____

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